Attorney File No.: 463037-00080

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

**KAYYEM** 

Serial No. 08/873,597

Filing Date: June 12, 1997

For:

AC Methods for the Detection of Nucleic

Acids

Examiner: FORMAN, Betty J.

Art Unit: 1634

Confirmation No. 2066

### CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that this correspondence, including listed enclosures, is being electronically transmitted in Portable Document Form (PDF) through EFS-Web via Hyper Text Transfer Protocol to the United States Patent and Trademark Office's Patent Electronic Business Center on:

Date:	October 10, 2006	
Signature	Hand .	
	Beent Yonehara	

# TERMINAL DISCLAIMER TO OBVIATE DOUBLE PATENTING REJECTION

Mail Stop Amendment Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

Sir:

Petitioner, Clinical Micro Sensors, Inc. (hereinafter "CMS"), represents that it is the assignee of the entire right, title, and interest of:

- 1. The instant application, U.S. Serial No. 08/873,597, filed June 12, 1997; and
- 2. U.S. Patent No. 7,014,992, filed June 12, 1997.

Assignments are recorded in the United States Patent and Trademark Office for U.S. Patent No. 7,014,992, filed June 12, 1997, at Reel No. 8866, Frame No. 0887, and Reel No. 010225, Frame No. 0660. A copy of these assignments are attached hereto.

CMS hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §§ 154-156 and 173, as shortened by any terminal disclaimer of U.S. Patent No. 7,014,992, filed June 12, 1997.

Serial No.: 08/873,597 Filed: June 12, 1997

CMS hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, CMS does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154-156 and 173 of U.S. Patent No. 7,014,992, filed June 12, 1997, as shortened by any terminal disclaimer, in the event that the patent later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer.

The undersigned is empowered to act on behalf of the petitioner/assignee. The undersigned has reviewed the evidentiary documents in the chain of title of the present application identified above, and certifies that, to the best of assignee's knowledge and belief, title is in the assignee CMS.

While Applicants believe that no other fees are due at this time, the Commissioner is authorized to charge the terminal disclaimer fee of \$65.00 under 37 C.F.R. 1.20(d), and any additional fees, including extension fees or any other relief that may be required, in connection with this reply to Deposit Account 50-2319 (Order No. 463037-00080; Docket No.: A-64558-1).

Serial No.: 08/873,597 Filed: June 12, 1997

The undersigned is an attorney or agent of record.

DORSEY & WHITNEY LLP

Dated: /0//0/0

Customer No.: 32940/

555 California Street, Suite 1000 San Francisco, CA 94104-1513 Telephone: (415) 781-1989

Facsimile: (415) 398-3249

By:

Robin M. Silva, Reg. No. 38,304

Attorneys of Record for Applicant

# A-63761-1/RFT, RMS

FEBRUARY 12, 1998

PTAS

FLEHR HOHBACH TEST ALBRITTON ET AL. ROBIN M. SILVA, ESQ. SUITE 3400 FOUR EMBARCADERO CENTER SAN FRANCISCO, CA 94111-4187





## UNITED STATES PATENT AND TRADEMARK OFFICE NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, NORTH TOWER BUILDING, SUITE 10C35, WASHINGTON, D.C. 20231.

RECORDATION DATE: 12/22/1997

REEL/FRAME: 8866/0987

NUMBER OF PAGES: 5

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

KAYYEM, JON FAIZ

DOC DATE: 07/07/1997

ASSIGNOR:

O'CONNOR, STEPHEN D.

DOC DATE: 07/07/1997

ASSIGNOR:

GOZIN, MICHAEL

DOC DATE: 07/07/1997

ASSIGNOR:

YU, CHANGJUN

DOC DATE: 07/07/1997

ASSIGNEE:

CLINICAL MICRO SENSORS, INC. 101 WAVERLY DRIVE

PASADENA, CALIFORNIA 91105

SERIAL NUMBER: 08873978

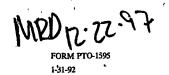
PATENT NUMBER:

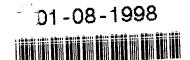
FILING DATE: 06/12/1997

ISSUE DATE:

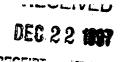
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SEDLEY PYNE, EXAMINER
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS





R SHEET



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U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

To the Honorable Assistant Commissioner for Patents and Trademarks. Please	record the attached original documents or copy thereof.
1. Name of conveying party(ies): JON FAIZ KAYYEM, STEPHEN D. O'CONNOR, MICHAEL GOZIN, CHANGJUN YU	2. Name and address of receiving party(ies): Name: CLINICAL MICRO SENSORS, INC. Internal Address:
Additional name(s) of conveying party(ies) attacted? [] Yes [x] No	
3. Nature of Conveyance:  [X] Assignment [] Merger  [] Security Agreement [] Change of Name  [] Other	Street Address: 101 Waverly Drive City: Pasadena Country U.S.A. Zip: 91105 Additional name(s) & address(es) attached? [] Yes [x] No
Execution Date: July 7, 1997	
4. Application number(s) or patent number(s):  If this document is being filed together with a new application, the execution da	ate of the application is:
A. Patent Application No.(s)	B. Patent No.(s)
08/873,978	
Additional numbers attack	ched? [] Yes [x] No
5. Name and address of party to whom correspondence concerning document should be mailed:	6. Total number of applications and patents involved: 1
Name: ROBIN M. SILVA, ESQ. Internal Address: FLEHR HOHBACH TEST ALBRITTON & HERBERT LLP	7. Total fee (37 CFR 3.41):\$40.00  [x] Enclosed [] Authorized to be charged to deposit account
Street Address: _SUITE 3400           FOUR EMBARCADERO CENTER           City:	8. Deposit account number: 06-1300 Please debit any underpayment or credit any overpayment to the above deposit account.  Our Order No. A-63761-1/RFT/RMS
DO NOT USE	THIS SPACE
the original document.  Robin M. Silva Name of Person Signing Sign	December 17, 1997  Date f pages including cover sheet, attachments and document: [5]
OMB No. 0651-0011 (exp. 4/94)	
Do not dated	h this nortion

Do not detach this portion

Mail documents to be recorded with required cover sheet information to:

Assistant Commissioner for Patents, Box Assignments Washington, DC 20231

File No. <u>A-63761-1/RFT/RMS</u>

Rev. 8/93 (575695)

### **ASSIGNMENT**

WHEREAS, the undersigned,	
(1) Jon Faiz Kayyem	, (2) Stephen D. O'Connor ,
(3) Michael Gozin	, (4) Changjun Yu ,
(hereinafter termed "Inventors"), residents of	
(1) Pasadena	, (2) Pasadena
(3) Pasadena	, (4) Pasadena
respectively, Counties of	
(1) Los Angeles	, (2) Los Angeles ,
(3) Los Angeles	, (4) Los Angeles
respectively, States of	
(1) California	, (2) California
(3) California	, (4) California ,
respectively, have invented certain new and useful i	mprovements in
ELECTRODES LINKED VIA CONDUCT	TIVE OLIGOMERS TO NUCLEIC ACIDS
and have executed an application for a United States	patent disclosing and identifying the invention on the
7th day of July 1997, and having Seria	al No. <u>08/873,97</u> &nd filing date of <u>12 June 1997</u>
_; and	

WHEREAS, <u>Clinical Micro Sensors</u>, <u>Inc.</u>, a corporation of the State of <u>Delaware</u>, having a place of business at <u>101 Waverly Drive</u>, <u>Pasadena</u>, State of <u>California</u>, (hereinafter termed "Assignee"), is desirous of acquiring the entire right, title and interest in and to said application and the invention disclosed therein, and in and to all embodiments of the invention, heretofore conceived, made or discovered jointly or severally by said Inventors (all collectively hereinafter termed "said invention"), and in and to any and all patents, inventor's certificates and other forms of protection (hereinafter termed "patents") thereon granted in the United States and foreign countries.

NOW, THEREFORE, in consideration of good and valuable consideration acknowledged by said Inventors to have been received in full from said Assignee:

- 1. Said Inventors do hereby sell, assign, transfer and convey unto said Assignee, the entire right, title and interest (a) in and to said application and said invention; (b) in and to all rights to apply for foreign patents on said invention pursuant to the International Convention for the Protection of Industrial Property or otherwise; (c) in and to any and all applications filed and any and all patents granted on said invention in the United States or any foreign country, including each and every application filed and each and every patent granted on any application which is a division, substitution, or continuation of any of said applications; and (d) in and to each and every reissue or extensions of any of said patents.
- 2. Said Inventors hereby jointly and severally covenant and agree to cooperate with said Assignee to enable said Assignee to enjoy to the fullest extent the right title and interest herein conveyed in the United

States and foreign countries. Such cooperation by said Inventors shall include prompt production of pertinent facts and documents, giving of testimony, execution of petitions, oaths, specifications, declarations or other papers, and other assistance all to the extent deemed necessary or desirable by said Assignee (a) for perfecting in said Assignee the right, title and interest herein conveyed; (b) for prosecuting any of said applications; (c) for filing and prosecuting substitute, divisional, continuing or additional applications covering said invention; (d) for filing and prosecuting applications for reissuance of any said patents; (e) for interference or other priority proceedings involving said invention; and (f) for legal proceedings involving said invention and any applications therefor and any patents granted thereon, including without limitation opposition proceedings, cancellation proceedings, priority contests, public use proceedings, infringement actions and court actions; provided, however, that the expense incurred by said Inventors in providing such cooperation shall be paid for by said Assignee.

- 3. The terms and covenants of this assignment shall inure to the benefit of said Assignee, its successors, assigns and other legal representatives, and shall be binding upon said Inventors, their respective heirs, legal representatives and assigns.
- 4. Said Inventors hereby jointly and severally warrant and represent that they have not entered and will not enter into any assignment, contract, or understanding in conflict herewith.

IN WITNESS WHEREOF, the said Inventors have executed and delivered this instrument to said Assignee as follows:

Date: July 1	1,1997 X (1)	Jon Faiz Kayyem	
County of Los And State of Californ	geles nìa	,) .) <sup>ss</sup> .	
of the State of <u>Califor</u> me <del>(or proved to me</del> the within instrument	of <u>July</u> , in the year <u>19</u> ornia, personally appeared (1) on the basis of satisfactory ex t, and acknowledged that he/ek signature on the instrument th	)Jon Faiz Kayyem <del>vidence)</del> to be the person w he-executed the same in his/	, personally known to hose name is subscribed to her authorized capacity(ies)
acted, executed the	instrument.		

WITNESS my hand and official seal.

Notary Public — California LOS ANGELES COUNTY My Comm. Expires FEB 27, 1998

PENELOPE WOLFE

(Seal)

<b>+</b>	Date: July 7, 1997 (2) Stephen D. O'Connor
	County of Los Angeles State of California. ,)ss.
	On this 7th day of July , in the year 1997, before me, Penelope Wolfe, Notary Public of the State of California, personally appeared (2) Stephen D. O'Connor, personally known to me
	(or proved to me on the basis of satisfactory evidence) to be the person whose name is subscribed to the
	within instrument, and acknowledged that he/she executed the same in his/her authorized capacity(ies); and
	that by his/her signature on the instrument the person, or the entity upon behalf of which the person acted,
	executed the instrument.
	WITNESS my hand and official seal.  PENELOPE WOLFE COMM. # 1018762 Notary Public — California LOS ANGELES COUNTY My Comm. Expires FEB 27, 1998
	Signature <u>Jenelyeli)olfe</u> (Seal)
<u>ሃ</u>	-Date: TJuly 1997 X (3) GOZiu Michael Gozin
	County of Los Angeles State of California ,)ss.
	On this 7th day of July, in the year 1997, before me, Penelope (1) Te, Notary Public of the State of California, personally appeared (3) Michael Gozin, personally known to me (or preved to me on the basis of satisfactory evidence) to be the person whose name is subscribed to the within instrument, and acknowledged that he/she executed the same in his/her authorized capacity(ies), and that by his/her signature on the instrument the person, or the entity upon behalf of which the person acted,
	executed the instrument.

PENELOPE WOLFE
COMM. # 1018762
Notary Public — Callfornia
LOS ANGELES COUNTY
My Comm. Expires FEB 27, 1998

(Seal)

WITNESS my hand and official seal.

Date: July 7. 1997	<b>Y</b> (4) CM
	Changjun Yu
County of Los Angeles State of California	,) .)ss.

On this 7th day of July, in the year 1997, before me, lene lope Wolfe. Notary Public of the State of California, personally appeared (4) Changjun Yu, personally known to me (er proved to me on the basis of satisfactory evidence) to be the person whose name is subscribed to the within instrument, and acknowledged that he/she executed the same in his/her authorized capacity(ies), and that by his/her signature on the instrument the person, or the entity upon behalf of which the person acted, executed the instrument.

WITNESS my hand and official seal.

Signature Zinelopellolfe

PENELOPE WOLFE
COMM. # 1018762
Notary Public — California
LOS ANGELES COUNTY
My Comm. Expires FEB 27, 1998

(Seal)

A-63761-1/2=T, RMS, RMK "MIES OF MARES OF MARES

NOVEMBER 15, 1999

PTAS

FLEHR HOHBACH TEST ALBRITTON ET AL. ROBIN M. SILVA FOUR EMBARCADERO CENTER SAN FRANCISCO, CALIFORNIA 94111-4187 UNITED STATES DEPARTMENT OF COMMERCE Patent and Trademark Office

ASSISTANT SECRETARY AND COMMISSIONER OF PATENTS AND TRADEMARKS Washington, D.C. 20231



UNITED STATES PATENT AND TRADEMARK OFFICE NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

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PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 09/13/1999

REEL/FRAME: 010225/0660 NUMBER OF PAGES: 3

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

MEADE, THOMAS J.

DOC DATE: 06/15/1999

ASSIGNEE:

CLINICAL MICRO SENSORS 101 WAVERLY DRIVE PASADENA, CALIFORNIA 91105

SERIAL NUMBER: 08873978

PATENT NUMBER:

FILING DATE: 06/12/1997

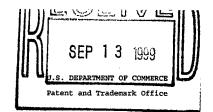
ISSUE DATE:

TARA WASHINGTON, EXAMINER ASSIGNMENT DIVISION OFFICE OF PUBLIC RECORDS

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1-31-92

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To the Honorable Assistant Commissioner for Patents and Trademarks. Please record the attached original documents or copy thereof. 1. Name of conveying party(ies): 2. Name and address of receiving party(ies): Name: Clinical Micro Sensors Thomas J. MEADE Internal Address: Additional name(s) of conveying party(ies) attached? [ ] Yes [X] No 3. Nature of Conveyance: Street Address: 101 Waverly Drive [X] Assignment [ ] Merger [ ] Security Agreement [ ] Change of Name City: <u>Pasadena</u> [ ] Other \_ State: <u>California</u> Zip: 91105 Country: <u>U.S.A.</u> Additional name(s) & address(es) attached? Execution Date: 15 June 1999 [X] No [ ] Yes 4. Application number(s) or patent number(s): If this document is being filed together with a new application, the execution date of the application is:\_ A. Patent Application No.(s) B. Patent No.(s) 08/873,978 Additional numbers attached? [ ] Yes [X] No 5 . Name and address of party to whom correspondence 6. Total number of applications concerning document should be mailed: 1 and patents involved: 7. Total fee (37 CFR 3.41):....\$\\\\\\_40.00 Name: Robin M. Silva Internal Address: FLEHR HOHBACH TEST ALBRITTON & HERBERT LLP [X] Enclosed [ ] Authorized to be charged to deposit account Street Address: Four Embarcadero Center 8. Deposit account number: \_ 06-1300 Please debit any underpayment or credit any City: <u>San Francisco</u> overpayment to the above deposit account. State: <u>California</u> Zip: <u>94111-4187</u> Our Order No. <u>A-63761-1/RFT/RMS/RMK</u> 09/1\$/1999 DCOATES 00000056 08873978 01 FC:581 40.00 OP DO NOT USE THIS SPACE 9. Statement and signature.. To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document Robin M. Silva (Reg. No. 38,304) Name of Person Signing Signature Total number of pages including cover sheet, attachments and document: [3] OMB No. 0651-0011 (exp. 4/94) Do not detach this portion Mail documents to be recorded with required cover sheet information to: Honorable Commissioner of Patents and Trademark Box Assignments Washington, DC 20231

### **ASSIGNMENT**

WHEREAS, the undersigned,	
(1) Thomas J. Meade	. (2)
(3)	, (4)
(hereinafter termed "Inventors"), residents of	
(1) Altadena	, (2)
(3)	
respectively, Counties of	
(1) Los Angeles	, (2)
(3)	
respectively, States of	
(1) California	, (2),
(3)	, (4),
respectively, have invented certain new and us	
ELECTRODES LINKED VIA CONI	DUCTIVE OLIGOMERS TO NUCLEIC ACIDS
	tates patent disclosing and identifying the invention on the
	erial No. <u>08/873,978</u> and filing date of <u>June 12, 1997</u> ;
and	

WHEREAS, <u>Clinical Micro Sensors</u>, a corporation of the State of <u>Delaware</u>, having a place of business at <u>101 Waverly Drive</u>, <u>Pasadena</u>, <u>California</u>, State of <u>California</u>, (hereinafter termed "Assignee"), is desirous of acquiring the entire right, title and interest in and to said application and the invention disclosed therein, and in and to all embodiments of the invention, heretofore conceived, made or discovered jointly or severally by said Inventors (all collectively hereinafter termed "said invention"), and in and to any and all patents, inventor's certificates and other forms of protection (hereinafter termed "patents") thereon granted in the United States and foreign countries.

NOW, THEREFORE, in consideration of good and valuable consideration acknowledged by said Inventors to have been received in full from said Assignee:

- 1. Said Inventors do hereby sell, assign, transfer and convey unto said Assignee, the entire right, title and interest (a) in and to said application and said invention; (b) in and to all rights to apply for foreign patents on said invention pursuant to the International Convention for the Protection of Industrial Property or otherwise; (c) in and to any and all applications filed and any and all patents granted on said invention in the United States or any foreign country, including each and every application filed and each and every patent granted on any application which is a division, substitution, or continuation of any of said applications; and (d) in and to each and every reissue or extensions of any of said patents.
- 2. Said Inventors hereby jointly and severally covenant and agree to cooperate with said Assignee to enable said Assignee to enjoy to the fullest extent the right title and interest herein conveyed in the United

States and foreign countries. Such cooperation by said Inventors shall include prompt production of pertinent facts and documents, giving of testimony, execution of petitions, oaths, specifications, declarations or other papers, and other assistance all to the extent deemed necessary or desirable by said Assignee (a) for perfecting in said Assignee the right, title and interest herein conveyed; (b) for prosecuting any of said applications; (c) for filing and prosecuting substitute, divisional, continuing or additional applications covering said invention; (d) for filing and prosecuting applications for reissuance of any said patents; (e) for interference or other priority proceedings involving said invention; and (f) for legal proceedings involving said invention and any applications therefor and any patents granted thereon, including without limitation opposition proceedings, cancellation proceedings, priority contests, public use proceedings, infringement actions and court actions; provided, however, that the expense incurred by said Inventors in providing such cooperation shall be paid for by said Assignee.

- 3. The terms and covenants of this assignment shall inure to the benefit of said Assignee, its successors, assigns and other legal representatives, and shall be binding upon said Inventors, their respective heirs, legal representatives and assigns.
- 4. Said Inventors hereby jointly and severally warrant and represent that they have not entered and will not enter into any assignment, contract, or understanding in conflict herewith.

IN WITNESS WHEREOF, the said Inventors have executed and delivered this instrument to said Assignee
this 15th day of June, 1999,
(1) Thomas J. Meade
Thomas J. Meade
County of Los Angeles State of California "ss.
On this 15 <sup>th</sup> day of <u>June</u> , in the year <u>1999</u> , before me, <u>Penelone Wolfe</u> , Notary Public of the State of <u>California</u> , personally appeared (1) <u>Thomas J. Meade</u> , personally known
o me (er proved to me on the basis of satisfactory evidence) to be the person whose name is subscribed
o the within instrument, and acknowledged that he same in his her authorized
capacity(ies), and that by(his/her signature on the instrument the person, or the entity upon behalf of which
he person acted, executed the instrument.
WITNESS my hand and official seal.  PENELOPE WOLFE Commission # 1172725 Noray Public - California

A-63761-1/RFT/RMS

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Los Angeles County My Comm. Expires Feb 27, 2002

(Seal)